

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Initially, the Examiner's attention is directed to the attached Request for Interview, in which Applicant is requesting that the Examiner contact his attorney for the purpose of arranging an interview in the event that the Examiner is of the opinion that there are issues remaining that must be resolved before the application can be allowed.

New claim 25 has been added to the application, and is supported by the disclosures at page 3, lines 11-15 and 18-25; page 4, lines 12-21; page 5, line 27 to page 6, line 10; page 7, lines 9-17; and page 10, line 3 of the specification.

The patentability of the presently claimed invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1-2, 5-6, 8, 11, 16, 19 and 22-23 under 35 U.S.C. 103(a) as being unpatentable over Mooney et al. (US '031) in view of Muta et al. (US '431) is respectfully traversed.

Applicant continues to rely on their arguments of record in support of the patentability of the presently claimed invention over these references. Additional arguments along these lines are set forth below.

Mooney et al. fail to disclose any (fiber) film, which is prepared by **heat-fusing** a soft plastic resin on a composite fiber prepared by entangling a natural fiber and a soft plastic fiber (in the range of 3-35 μ m), or any (fiber) film, which is prepared by **heat-fusing** a plastic resin having a soft part and a hard part in common on a fiber consisting of a plastic having a soft part and hard part in common (in the range of 7-70 μ m). Although this reference discloses a composite fiber prepared by entangling a natural fiber and a soft plastic fiber, a fiber consisting of a plastic having a soft part and hard part in common is not disclosed therein.

As explained above, the film itself of the present invention is completely different from the one in Mooney et al. The Examiner believes that both films (Mooney et al. and the present invention) are the same, and neglects the characteristics of the film of the present invention and the properties based thereon (see page 3, lines 18-25, etc. in the specification), taking the position that the claims are drawn to a product prepared by a particular process, however,

patentability is based on the final product. Nevertheless, the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product (MPEP 2113). This section of the MPEP refers to case law (*In re Garnero*) holding “interbonded by interfusion” to limit the structure of the claimed composite and noting that terms such as “welded,” “intermixed,” “ground in place,” “press fitted,” and “etched” are capable of construction as structural limitations. Applicant takes the position that the “heat-fusing” language in the present claims does not simply relate to the process for preparing the final product, but rather, imparts a structural limitation to the final product, that is neither disclosed in nor suggested by the references applied by the Examiner in rejecting the claims.

The Examiner states that the Mooney et al. reference discloses a structured occlusive dressing which is a soft plastic resin and the specific resin of claims 6 and 14-16. However, claims 14-16 relate to the occlusive dressings and do not relate to the films.

The Examiner further states that the dressings may also be coated onto a fiber substrate which in turn, is adhesively or otherwise attached to a film substrate; and that Mooney et al. disclose a fiber substrate including fabrics that are knitted such as modified entangled fiber composed of rayon polyesters, such as 90:10 polypropylene-rayon blends which is the particular combination disclosed in instant claims 6 and 14-16. However, as noted above, claims 14-16 relate to the occlusive dressings and do not relate to the films. This substrate corresponds only to the composite fiber prepared by entangling a natural fiber and a soft plastic fiber as mentioned above.

The Examiner also states that Mooney et al. additionally disclose generic teachings of adhesive surfaces applied to the film (Example 1). However, this film is a **nonwoven** substrate (see line 9 of Example 1), which is different from the **heat-fused** film of the present invention.

Referring to the Response to Arguments section beginning on page 6 of the Office Action:

(1) With regard to the Examiner’s remark concerning Applicant’s argument that “the dressing of Mooney has a porous cover as an essential component”, although the Examiner insists that the instant claims do not exclude the presence of such a cover, it is clear that there is no ability to include a porous cover in the cataplasm claimed in the instant claims because the

cataplasms is very thin. Accordingly to Table 1 of Mooney et al., it is shown that delamination occurred between the occlusive composition 115 and the support 110 on the specimen without porous covering materials when a release sheet is removed. That means specimens without porous covering materials are useless. From these data, it is recognized that the cataplasms of the present invention makes it unnecessary to use porous covering materials, different from the occlusive dressing of Mooney et al.

(2) With regard to the Examiner's remark concerning Applicant's argument that "there is a possibility that the adhesive...", Applicant respectfully submits this is common sense for a skilled person in the art.

(3) With regard to the Examiner's remark concerning Applicant's argument that "Muta et al. discloses cataplasms comprising a base of a gel patch", does the Examiner opine what effects are attained when adhesives disclosed in Muta et al. are used in the occlusive dressing of Mooney et al.? Does the Examiner think that the occlusive dressing without porous covering materials can attain the same effects as the occlusive dressing with porous covering materials? By combining such two different techniques (Mooney et al. and Muta et al.), what effects are expected? Applicant submits that these questions raise uncertainty about the result of combining the Mooney et al. and Muta et al. references. In this regard, in order to reject a claim based on a combination of references, the Examiner must articulate, *inter alia*, "a finding that there was reasonable expectation of success" (MPEP 2143(G)). The Examiner has failed to articulate such a finding, and as indicated by this same section of the MPEP, the absence of such a finding defeats the Examiner's conclusion that the claims would have been obvious to one of ordinary skill in the art based on a combination of the references.

Another requirement for a rejection based on a combination of references is that the Examiner must articulate a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings (MPEP 2143(G)). Applicant continues to take the position that, in view of the completely different techniques between the Mooney et al. and Muta et al. references as already discussed, there would have been no motivation for the art-skilled to have combined these references.

Furthermore, because of the distinctions between the present invention and Mooney et al. as discussed above, even if the references were combined, the result of such combination would still not suggest the presently claimed invention.

For these reasons, Applicant takes the position that the present invention as claimed is clearly patentable over the applied references.

Therefore, in view of the foregoing remarks, it is submitted that the ground of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Information Disclosure Statements

The Examiner is kindly reminded that Fifth and Sixth Information Disclosure Statements were filed on December 10, 2009 and February 3, 2010, after issuance of the Office Action. The Examiner's consideration of those IDSs is requested.

Respectfully submitted,

Sadanobu SHIRAI

By



Michael R. Davis

Registration No. 25,134

Attorney for Applicant

MRD/cbc
Washington, D.C. 20005-1503
Telephone (202) 721-8200
Facsimile (202) 721-8250
March 5, 2010